

REMARKS

Applicant respectfully requests entry of the following amendments and remarks contained herein in response to the Office Action mailed April 19, 2005. Applicant respectfully submits that the amendment and remarks contained herein place the instant application in condition for allowance.

Upon entry of the amendments in this response, claims 16 and 18 remain pending. In particular, Applicant amends claim 16 and cancels claims 14, 15, and 19 – 22 without prejudice, waiver, or disclaimer. Applicant cancels these claims merely to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicant reserves the right to pursue the subject matter of these canceled claims in a continuing application, if Applicant so chooses, and does not intend to dedicate the canceled subject matter to the public. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

I. Examiner Interview

Applicant first wishes to express his sincere appreciation for the time that Examiner Huang spent with Applicant's Attorneys, Jeff Kuester, and Anthony Bonner during a telephone discussion on May 19, 2005 regarding the outstanding Office Action. During that conversation, Examiner Huang seemed to indicate that it would be potentially beneficial for Applicant to make amendments contained herein. More specifically, Examiner Huang seemed to indicate that incorporating the limitations of claim 16 into claim 14 could be potentially beneficial. Thus, Applicant respectfully requests that Examiner Huang carefully consider this response and the amendments.

II. Rejections Under 35 U.S.C. §103

In order for a claim to be properly rejected under 35 U.S.C. §103, the teachings of the cited art reference must suggest all features of the claimed invention to one of ordinary skill in the art. *See, e.g., In re Dow Chemical*, 837 F.2d 469, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 642 F.2d 413, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981). Further, “[t]he PTO has the burden under section 103 to establish a prima facie case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fine, Minnesota Mining and Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

A. Claims 14, 15, and 19 – 20 are Patentable Over *Alonso* in View of *Komiya*

The Office Action indicates that claims 14, 15, and 19 – 22 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable. Applicant respectfully traverses these rejections, but cancels these claims. Applicant submits that these rejections are now moot.

B. Claim 16 is Patentable Over *Alonso* in View of *Komiya*

The Office Action indicates that claim 16 stands rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Alonso* in view of *Komiya*. Applicant respectfully traverses this rejection for at least the reason that *Alonso* in view of *Komiya* fails to disclose, teach, or suggest all of the elements of claim 16. Claim 16, as amended recites:

A mobile communication device, comprising:
a housing;
a mobile pager operably supported by said housing; and

a self-contained audio recorder operably supported by said housing,

wherein said mobile pager comprises:

a first microprocessor supported by said housing;

microprocessor support circuitry communicating with said first microprocessor;

an interface controller operably connected to said microprocessor support circuitry;

a display screen communicating with said interface controller;

a keypad connected to said interface controller;

transmitter receiver circuitry connected to said audio processing and microprocessor support circuitry; and

an antenna communicating with said transmitter receiver circuitry,

wherein said self-contained audio recorder comprises:

a second microprocessor supported by said housing;

an input device communicating with said second microprocessor;

record and playback circuitry coupled to said second microprocessor for recording a signal on a recording medium;

a microphone communicating with said second microprocessor through said record and playback circuitry; and

a speaker communicating with said second microprocessor through said record and playback circuitry.

Applicant submits that neither *Alonso* nor *Komiya* disclose, teach, or suggest a “mobile communications device... wherein said self-contained audio recorder comprises: ***a second microprocessor supported by said housing***” as recited in claim 16, as amended.

In addition, Applicant points out that claim 16 is in its original form and submits that this claim is allowable. However, if a subsequent Office Action is necessary, Applicant respectfully submits that this Office Action must be non-final.

C. Claim 18 is Patentable Over *Alonso and Komiya* in View of *Pawlowski*

The Office Action indicates that claim 18 stands rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Alonso* and *Komiya* as applied to claim 16, and further in view of U.S. patent number 6,038,199 to Pawlowski ("*Pawlowski*")... Applicant respectfully traverses this rejection for at least the reason claim 18 depends from allowable independent claim 16. *In re Fine, Minnesota Mining and Mfg.Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

III. Inherency Cited

With respect to claims 15 and 20, the Office Action recites that microprocessor support circuitry is "implemented inherently within said first microprocessor to support ports and bus of said first microprocessor and the surrounding control circuitry" (OA p. 3, fourth full paragraph and OA p. 6, first full paragraph). Applicants respectfully traverse this finding of inherency and submit that the subject matter noted above should not be considered inherent. It is well established that "[t]o establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In Re Anthony J. Robertson*, 98-1270 (Fed. Cir. 1999).

The Office Action additionally indicates that, with respect to claim 20, a switch matrix communicating with said microprocessor is "inherently implemented within the 'Keyboard Matrix'" (OA p. 6, eighth full paragraph). Applicants respectfully traverse this finding of

inherency and submit that the subject matter noted above should not be considered inherent since the Office Action does not include the extrinsic evidence making clear that the missing descriptive matter is necessarily present, as required.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested.

In addition, any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions.

If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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